

Remarks/Arguments

Claims 1-28 were originally pending, of which claims 7, 8, and 28 have been amended and claims 29-33 have been added. Claims 1-33 are now pending. Reconsideration of this application in light of the above amendments and the following remarks is requested.

Rejections Under 35 U.S.C. §103:

Claims 1-13 and 23-28 were rejected under 35 U.S.C. ' 103 as being anticipated by U.S. Patent No. 6,414,950 to Rai et al. ("Rai") in view of U.S. Patent No. 6,553,015 to Sato ("Sato"). Claims 14-22 were rejected under 35 U.S.C. ' 103 as being unpatentable over Rai in view of Sato and further in view of U.S. Patent No. 6,252,851 Sin et al. ("Sin"). Applicant traverses these rejections on the grounds that the above references are defective in establishing a prima facie case of obviousness with respect to all these claims.

As provided in MPEP ' 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP ' 2142,

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

It is submitted that, in the present case, the examiner cannot factually support a prima facie case of obviousness for the following, mutually exclusive, reasons.

Claim 1**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

Claim 1 requires that "upon initiation of the handoff, sending a first message to the first agent requesting the first agent to buffer any packets being sent to the mobile node." Although Rai teaches the forwarding of buffered packets of data from a first agent of a first wireless hub to a second agent of a second wireless hub, Rai is silent with regard to any buffering request messages sent to the first agent. Rai does not teach any buffer management algorithm. Although

Sato discusses the sending of a buffering request message, Sato teaches an algorithm comprising the step of “holding the upstream ATM cells in a mobile-site buffer immediately following the transmission of the handoff request message” (col. 2, lines 15-17, emphasis added). Moreover, Sato only claims the same limited algorithm of “holding the upstream ATM cells in a first buffer located in said mobile site immediately following the transmission of said handoff request message” (col. 9, lines 9-11, emphasis added). So while Sato teaches and claims a buffer management algorithm, the algorithm taught and claimed is very different from the present invention.

Thus, for this mutually exclusive reason, the examiner=s burden of factually supporting a prima facie case of obviousness clearly cannot be met, and any rejection under 35 U.S.C. '103 is not applicable to Claim 1.

2. The Combination of References is Improper

There is still another, mutually exclusive, and compelling reason why the Rai and Sato patents cannot be applied to reject Claim 1 under 35 U.S.C. ' 103.

' 2142 of the MPEP also provides

...the examiner must step backward in time and into the shoes worn by the hypothetical >person of ordinary skill in the art= when the invention was unknown and just before it was made. ... The examiner must put aside knowledge of the applicant=s disclosure, refrain from using hindsight, and consider the subject matter claimed >as a whole. '

Here, neither Rai or Sato teaches, or even suggests, the desirability of the combination of Claim 1 since neither teaches that “upon initiation of the handoff, sending a first message to the first agent requesting the first agent to buffer any packets being sent to the mobile node.” Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. ' 103 rejection of Claim 1.

In this context, the MPEP further provides at ' 2143.01

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination of the Rai and Sato patents arises solely from hindsight based on the invention without any showing, suggestion, incentive, or motivation in either reference for the combination as applied to Claim 1. Rai teaches the sending of buffered data from a first agent of a first wireless hub to a second agent of a second wireless hub. Sato teaches and claims a completely different mobile communications buffering system, one in which a mobile node, and not an agent of a wireless hub, performs the buffering and the subsequent sending of buffered data. Sato's algorithm used to provide buffer management for a system that buffers data in the mobile node could not be applied to, nor combined with, Rai's mobile communication system that teaches the buffering of data in an agent of a wireless hub, and not in the mobile node. Sato's algorithm is not compatible with the system as taught in Rai. If Sato's algorithm were to be applied to the system taught in Rai, the intended purposes of both Rai and Sato would be destroyed. Clearly, neither patent provides any incentive or motivation supporting the desirability of the combination.

Therefore for this mutually exclusive reason, the examiner=s burden of factually supporting a prima facie case of obviousness clearly cannot be met, and the rejection under 35 U.S.C. '103 is not applicable to Claim 1.

Accordingly, Claim 1 is allowable over the cited references. Claims 2-6 depend from and further limit Claim 1 and are also allowable.

Claim 7

Claim 7 requires "upon initiation of the handoff, the second agent sending a first message to the first agent requesting the first agent to buffer any packets being sent to the mobile node,"

As discussed above, Rai is silent with regard to any buffering request messages sent from a second agent to a first agent. Rai does not teach any buffer management algorithm. Similarly, while Sato discusses the sending of a buffering request message, Sato teaches a buffer management algorithm that does not make obvious the elements of the algorithm in the present invention. Sato teaches an algorithm comprising the step of “holding the upstream ATM cells in a mobile-site buffer immediately following the transmission of the handoff request message” (col. 2, lines 15-17, emphasis added). Moreover, Sato only claims the same limited algorithm of “holding the upstream ATM cells in a first buffer located in said mobile site immediately following the transmission of said handoff request message” (col. 9, lines 9-11, emphasis added). So while Sato discusses and claims a buffer management algorithm, the algorithm taught and claimed is very different from the present invention.

Claim 8

Claim 8, as amended, recites “A software program for facilitating a handoff of a mobile node from a first agent to a second agent, the software program comprising instructions for: (i) determining that the handoff is to be initiated; (ii) before the transmission of a handoff request message, sending a first message to the first agent requesting the first agent to buffer any packets being sent to the mobile node; (iii) completing the handoff to the second agent; and (iv) signaling the first agent to forward the buffered packets to the second agent.”

Claim 8 is an independent claim for the software program implementing the method for supporting a handoff of a mobile node as described in Claim 1. The software program’s obviousness and rejection under 35 U.S.C. ' 103 can only be established if its underlying method is first determined to be obvious. However, since Claim 1 is allowable, the software program that implements its method is allowable.

Accordingly, Claim 8 is allowable over the cited references. Claims 9-22 depend from and further limit Claim 8 and are also allowable.

Claim 23

Claim 23, as previously presented, recites “A software program for a new agent of a new network to initiate communication with a mobile node, the software program comprising instructions for: (i) determining that the handoff is to be initiated; (ii) sending a first message to the old agent requesting the old agent to buffer any packets being sent to the mobile node; (iii) completing the handoff to the second agent; and (iv) signaling the old agent to forward the buffered packets to the new agent.”

Claim 23 is an independent claim for the software program implementing the method for supporting a handoff of a mobile node as described in Claim 1. The software program’s obviousness and rejection under 35 U.S.C. ' 103 can only be established if its underlying method is first determined to be obvious. However, since Claim 1 is allowable, the software program that implements its method is allowable.

Accordingly, Claim 23 is allowable over the cited references. Claims 24-27 depend from and further limit Claim 23 and are also allowable.

Claim 28

Claim 28, as amended, recites “A system for supporting a handoff of a mobile node from a first agent of a first network to a second agent of a second network, the system comprising: (i) means for sending, before the transmission of a handoff request message, a first message to the first agent requesting the first agent to buffer any packets being sent to the mobile node; (ii) means for completing the handoff to the second agent; and (iii) means for sending a second message to the first agent requesting the first agent to forward the buffered packets to the second agent.”

Claim 28 is an independent claim for the system implementing the method for supporting a handoff of a mobile node as described in Claim 1. The system’s obviousness and rejection under 35 U.S.C. ' 103 can only be established if its underlying method is first determined to be obvious. However, since Claim 1 is allowable, the system that implements its method is allowable.

Accordingly, Claim 28 is allowable over the cited references.

Conclusion

It is clear from all of the foregoing that independent Claims 1, 7, 8, 23, 28, and 31 are in condition for allowance. Dependent Claims 2-6, 9-22, 23-27, 29-30, and 32-33 depend from and further limit independent claims and therefore are allowable as well.

An early formal notice of allowance of Claims 1-33 is requested.

Respectfully submitted,



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